

REMARKS/ARGUMENTS

Claims 1-23 are pending in the application. Claims 1-23 are submitted to clearly distinguish patentably over the prior art for the reasons discussed hereafter.

In paragraph 5 which begins on page 2 of the Office Action, claims 1-10, 12-21 and 23 are rejected Under 35 U.S.C. § 103(a) as being unpatentable over Savitch in further view of Sedgewick. In paragraph 6 which begins on page 8 of the Office Action, claims 11 and 22 are rejected Under 35 U.S.C. § 103(a) as being unpatentable over Savitch and Sedgewick in further view of U.S. Patent 6,149,325 of Nunokawa et al. These rejections are respectfully traversed.

As previously noted by Applicant, Savitch and Sedgewick are said in the Office Action to disclose all of the limitations of claims 1, 12 and 23 of the present application. In this connection, however, Applicant respectfully refers the Examiner to some of the steps of the present invention. Because of such steps (i.e., the last step in claim 1), there can be achieved the advantages as described at line 26 of page 8 through the last line of page 9. In particular, the present character processing method and apparatus according to the present invention make it possible to select the text for processing without carrying out any special operation for reading/writing the same or other text. Furthermore, in this case, it is not required to display the plurality of text simultaneously, and therefore a large-size display screen is not needed, as discussed at lines 24-26 of page 9.

In this connection, the Office Action simply refers to pages 610 and 611 of Savitch, implying that such advantages can also be attained by Savitch. However, this is clearly not so. Savitch relates only to programming text having in mind no problems at all related to the prior art, such as that described on page 2 in the last paragraph of "prior art" and "object" in the "Summary Of The Invention" thereof.

Appl. No. 10/034,639
Amdt. Dated July 20, 2005
Reply to Office Action of April 29, 2005

Attorney Docket No. 81752.0118
Customer No.: 26021

Simply describing the method of programming as in Savitch without any relation to the concrete problems simply will not lead a person skilled in the art to the method in accordance with the present invention so as to thereby solve the problems noted above.

Accordingly, the Office Action appears to be simply picking fragments of disclosures from the references such as Savitch without any relation to the “problems to be solved by the invention”, “advantages that can be attained by the invention”, and so forth. In this connection, the Examiner’s attention is directed to the decision of January 6, 2005 by the United States Court Of Appeals for the Federal Circuit in the matter of Teleflex, Incorporated and Technology Holding Company v. KSR International Co., copies of appropriate portions of which are attached hereto. In particular, the Examiner’s attention is directed to the Court’s statement on page 11 thereof that “the test requires that the nature of the problem to be solved be such that it would have lead a person of ordinary skilled in the art to combine the prior art teachings in the particular manner claimed” citing Rouffet, 149 F. 3d at 1357. And on pages 14 and 15 thereof, the Court states that the District Court erred as a matter of law “by applying an incomplete teaching-suggestion-motivation test to it obviousness determination”. The Court further stated that genuine issues of material fact exist as to “whether a person of ordinary skill in the art would have been motivated”.

In the present instance, Savitch must be said to relate only to programming text having in mind no problems at all related to the prior art, thereby offering no motivation at all to the inventor to look to or to combine the references for a solution.

Appl. No. 10/034,639
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Therefore, claims 1-23 are submitted to clearly distinguish patentably over the attempted combination of Savitch and Sedgewick and the further combination of those two references with Nunokawa.

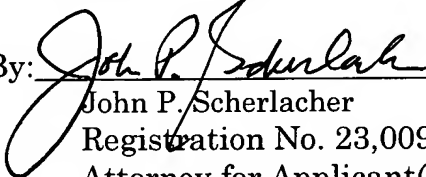
Reconsideration and allowance in view of the above comments are respectfully requested.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

Date: July 20, 2005

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NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition
is not citable as precedent. It is a public record.

United States Court of Appeals for the Federal Circuit

04-1152

TELEFLEX, INCORPORATED and
TECHNOLOGY HOLDING COMPANY,

Plaintiffs-Appellants,

v.

KSR INTERNATIONAL CO.,

Defendant-Appellee.

DECIDED: January 6, 2005

Before MAYER,* SCHALL, and PROST, Circuit Judges.

SCHALL, Circuit Judge.

DECISION

Teleflex Incorporated and Technology Holding Company (collectively, "Teleflex") sued KSR International Co. ("KSR") in the United States District Court for the Eastern District of Michigan for infringement of U.S. Patent No. 6,237,565 B1 ("the '565 patent"). On December 12, 2003, the district court granted summary judgment in favor of KSR,

Judge Haldane Robert Mayer vacated the position of Chief Judge on December 24, 2004.

district court was required to make specific findings as to whether there was a suggestion or motivation to combine the teachings of Asano with an electronic control in the particular manner claimed by claim 4 of the '565 patent. See Kotzab, 217 F.3d at 1371; Rouffet, 149 F.3d at 1357. That is, the district court was required to make specific findings as to a suggestion or motivation to attach an electronic control to the support bracket of the Asano assembly.

The district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed. See Rouffet, 149 F.3d at 1357. We have recognized this situation when two prior art references address the precise problem that the patentee was trying to solve. See Ruiz, 357 F.3d at 1276 ("This record shows that the district court did not use hindsight in its obviousness analysis, but properly found a motivation to combine because the two references address precisely the same problem of underpinning existing structural foundations."). In this case, the Asano patent does not address the same problem as the '565 patent. The objective of the '565 patent was to design a smaller, less complex, and less expensive electronic pedal assembly. The Asano patent, on the other hand, was directed at solving the "constant ratio problem."³ The district court's reliance on the problems associated with the Rixon '593 patent similarly fails to provide a sufficient motivation to combine. This is

³ The constant ratio problem refers to the problem of creating an assembly where the force required to depress the pedal remains constant irrespective of the position of the pedal on the assembly. See Asano patent, col. 1, l. 48—col. 2, l. 13.

(Willemssen Decl. at ¶ 34, 37, 39.) This statement may be factually correct. However, the issue is not whether a person of skill in the art had a motivation to combine the electronic control with an adjustable pedal assembly, but whether a person skilled in the art had a motivation to attach the electronic control to the support bracket of the pedal assembly.

In addition, Teleflex offered two declarants—Clark J. Radcliffe, Professor of Mechanical Engineering at Michigan State University; and Timothy L. Andresen, a former engineer at Ford Motor Company and McDonnell-Douglas Corporation—in rebuttal of the declaration of Mr. Willemssen. Mr. Radcliffe stated, *inter alia*, that “[t]he location of the electronic control” (Radcliffe Decl. at ¶ 15) in claim 4 “was a simple, elegant, and novel combination of features,” (Radcliffe Decl. at ¶ 16) as opposed to the Rixon '593 patent’s attachment of the electronic control to the assembly housing, which was both electrically and mechanically complex (Radcliffe Decl. at ¶ 17). Mr. Andresen also stated that the non-obviousness of claim 4 was reflected in Rixon’s choice to mount the electronic control to the assembly housing instead of the assembly’s support bracket. (Andresen Decl. at ¶ 5.) At the summary judgment stage of a proceeding, it is improper for a district court to make credibility determinations. *See, e.g., Jones*, 727 F.2d at 1531. Therefore, by crediting KSR’s expert declarant and discrediting the two declarants offered by Teleflex, the district court erred as a matter of law.

V.

In sum,

(1) We hold that, in granting summary judgment in favor of KSR, the district court erred as a matter of law by applying an incomplete teaching-suggestion-motivation

test to its obviousness determination. The correct standard requires a court to make specific findings showing a teaching, suggestion, or motivation to combine prior art teachings in the particular manner claimed by the patent at issue.

(2) Under this standard, we hold that genuine issues of material fact exist as to whether a person of ordinary skill in the art would have been motivated, at the time the invention was made, to attach an electronic control to the support structure of the pedal assembly disclosed by the Asano patent.

(3) We consequently vacate the decision of the district court and remand the case for further proceedings on the issue of obviousness, and, if necessary, proceedings on the issues of infringement and damages.

Each party shall bear its own costs.